

Application No.: 10/659,506

REMARKS

Reconsideration of this application is respectfully requested.

The examiner indicated an inability to retrieve published US patent application US 2002/0100855 that was properly cited in Applicant's Information Disclosure Statement and, to the knowledge of undersigned counsel, submitted in paper form along with the Information Disclosure Statement. As a courtesy to the examiner, a copy of US 2002/0100855 was previously submitted along with a new form PTO-1449 on which the examiner is respectfully requested to indicate consideration of this document. Applicant's original IDS was submitted in a timely manner in accordance with applicable rules, therefore no fee or declaration is required with the submission of US 2002/0100855 to the examiner for consideration.

By this Amendment, Applicant has amended claims 13 – 20. Claims 1 – 20 are pending in this application. No new matter has been introduced into the application by this Amendment. The amendments to claims 14 – 17 and 20 are not narrowing amendments because the amendment merely conform the claims to proper dependency that was clearly understood by the examiner in connection with the original claims. Claim 13 is amended to improve its form by moving the connector "and" between the steps so that it appears after step (d) rather than after step (c). This amendment to claim 13 is clearly not a narrowing amendment. Claims 18 and 19 are amended to depend from claim 17 to provide proper antecedent basis for the fastener recited in these claims. No change to the scope of claims 18 and 19 results from these amendments.

The examiner rejected claims 14 – 19 under 35 USC §112 in connection with clerical errors relating to claim dependency. Claims 14 – 17 are amended above to correct their dependency to properly depend from claim 13 as understood by the

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examiner. Claims 18 and 19 are amended to correct a dependency error not noted by the examiner.

The examiner also rejected claim 20 under 35 USC §112 in connection with multiple dependencies. Claim 20 is amended to remove multiple dependencies and to depend only from claim 1.

The examiner rejected claims 1, 6, 12, 13, and 17 – 19 under 35 USC §102(b) as being anticipated by Ebesu et al. (US 5 197 423). Applicant respectfully traverses this rejection.

Claim 1 and the claims depending therefrom recite a mounting bracket arrangement that includes a first surface lying substantially in a first plane, a second surface lying substantially in a second plane, and a mounting bracket having a portion contacting the first surface. The bracket also has a passage extending therethrough adjacent the second surface. An adjustment member is positioned in the passage and has an end surface contacting the second surface. The adjustment member is adjustable along an axis, and the bracket is adapted to support a load transverse to the axis. Ebesu et al. clearly does not disclose this arrangement.

The examiner asserts that Ebesu et al. anticipates claims 1, 6, 13, and 17 – 19 but fails to acknowledge even the presence of several limitations of the claims. In support of this assertion, the examiner states that both portions 17 and 44 of the Ebesu et al. bracket 40 "have a passageway and a bolt (41 and 43) extending through the passageway and penetrating into the surface." In this regard, Applicant notes that claim 1 does not recite any bolt or fastener; thus, the examiner's reference to Ebesu et al. bolts 41 and 43 is not understood in connection with claim 1. More importantly, the examiner fails to even acknowledge the recitation in the claims of an adjustment member that is received in a passage in a bracket and adjustable along

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an axis. This feature of the claimed invention is not disclosed or in any way taught or suggested by Ebesu et al.

Although the examiner's basis for concluding that Ebesu et al. discloses an adjustment member as recited in claim 1 is unclear, the bolts 41 and 43 of Ebesu et al. apparently relied upon by the examiner cannot be considered adjustment members, as Ebesu et al. makes clear to one skilled in the art that the bolts 41 and 43 must be tightened with adequate torque to clamp the Ebesu et al. bracket in place. The Ebesu et al. bolts cannot, in use, be adjusted along an axis relative to a bracket without destroying the function of the Ebesu et al. device. The disclosure of the Ebesu et al. patent states nowhere that the Ebesu et al. bolts 41 and 43 can provide any adjustment function, consequently the bolts 41 and 43 cannot be considered adjustment members.

Moreover, with regard to claim 6, the claims recite both an adjustment member and at least one removable fastener that secures the adjustment member to at least one of the recited surfaces. This is clearly not disclosed by or even suggested by Ebesu et al.

Claim 13 and the claims depending therefrom recite a method for mounting an article to a first surface lying substantially in a first plane and a second surface lying substantially in a second plane, comprising the steps of a) positioning a mounting bracket adjacent the first and second surfaces; b) causing a portion of the mounting bracket to contact the first surface; c) engaging an adjustment member in a passage extending through the bracket adjacent to the second surface; d) adjusting the position of the adjustment member along an axis until an end surface of the adjustment member contacts the second surface; e) mounting an article to the bracket such that the bracket supports a load from the article transverse to the axis.

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The remarks presented above with regard to mounting arrangement of claim 1 apply equally to the method of claim 13. Further, remarks presented above with regard to claim 6 apply equally to claim 17. Claim 18 depends from claim 17 and recites that the adjustment member has a longitudinal passage and that the fastener extends through the passage. Ebesu et al. clearly does not teach this feature. Claim 19 depends from claim 17 and is not anticipated for at least the same reasons as claims 13 and 17.

Because Ebesu et al. fails to disclose each and every element recited in claims 1, 6, 12, 13, and 17 – 19, the examiner's rejection of the claims under 35 USC §102 is not supported and should be withdrawn.

The examiner rejected claims 2 – 5, 8 – 11, and 14 – 19, under 35 USC §103 as being unpatentable over Ebesu et al. This rejection is inappropriate and should be withdrawn for the same reasons set forth above with regard to claims 1, 6, 12, 13, and 17 – 19. Ebesu et al. simply does not disclose or suggest an adjustment member as recited in the claims. Further, claims 2 – 5, 8 – 11, and 14 – 19 recite additional limitations that are not taught or suggested by Ebesu et al. For example, with regard to claims 2 and 14, nothing in Ebesu et al. suggests an adjustment member as recited in the claims threadedly engaged in a passage (and notably, one skilled in the art would understand that even the bolts 41 and 43 of Ebesu et al. would not be threadedly engaged in passages extending through the Ebesu et al. bracket 40). Similarly, claims 8 and 18 recite that the adjustment member has a longitudinal passage and that the fastener extends through the passage, which is a feature not taught or even suggested by Ebesu et al.

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The examiner presented no prior art rejections of claim 20. However, claim 20 depends from claim 1 and is considered allowable for at least the same reasons set forth about with regard to claim 1.


The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In view of the foregoing remarks and amendments, this application is considered in condition for allowance. Favorable action is requested.

Respectfully submitted,

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